

REMARKS

Applicant has carefully studied the Office Action of June 10, 2004 and offers the following remarks in response thereto.

Claims 1-7 and 11-23 were rejected under 35 U.S.C. § 103 as being unpatentable over Amin et al. (hereinafter "Amin") in view of Tsoukas. Applicant respectfully traverses.

Applicant previously set forth the standard for creating a rejection under 35 U.S.C. § 103. Applicant presents it again for convenience. Before the Patent Office can assert *prima facie* obviousness based on a combination of references, the Patent Office must properly combine the references. To combine the references, the Patent Office must indicate 1) a motivation to combine the references and 2) provide actual evidence that the motivation to combine comes from a proper source. *In re Dembiczak*, 175 F.3d 994, 999 (Fed. Cir. 1999). Further, the Patent Office is not free to ignore portions of the references being combined. Specifically, if a portion of the reference teaches away from the combination, that is evidence of non-obviousness. MPEP § 2143.01. Likewise, if a combination renders a reference unsuitable for its intended purpose, then this is further evidence of non-obviousness. *Id.* Once the combination is properly made, the combination must still show each and every claim element to establish *prima facie* obviousness. MPEP § 2143.03.

Applicant initially argued that the Patent Office had not produced any evidence to support the motivation to combine Amin and Tsoukas. Applicant reminds the Patent Office that merely because a combination is possible, it is not necessarily obvious to combine the references unless there is some motivation in the record to combine the references. Applicant acknowledges that most inventions are combinations of elements that exist in the prior art. However, one of the things that makes an invention patentable is that there is no suggestion in the prior art to combine the old elements in the manner claimed. To help avoid "the insidious effect of a hindsight syndrome", the Federal Circuit has laid out specific guidelines about from where the motivation to combine the references may come, and what is required to substantiate the motivation. *In re Kotzab*, 217 F.3d 1365, 1370 (Fed. Cir. 2000). Regardless of the source of the motivation, there is no diminishment of the requirement that the Patent Office provide actual evidence to support the motivation. *Id.*

The Patent Office, in its primary rejection of claims 1-7 and 11-23, relies on essentially the same motivation articulated in the previous Office Action. Specifically, on page 3 of the

Office Action, the Patent Office opines that it would have been obvious to employ the teachings of Tsoukas in the system of Amin so that “users may receive any desired information based on time or predetermined times, location, and event triggers that outline when certain types [of] information are to be delivered through a plurality of communication devices.” The only difference between this analysis and the analysis on pages 3 and 13 of the Office Action of March 9, 2004 is the “through a plurality of communication devices” language. As Applicant previously argued, this motivation is not properly supported with the requisite actual evidence.

The Patent Office summarizes Applicant’s position in the “Arguments & Responses” section (beginning on page 15 of the current Office Action) by stating “[b]oth references of Amin and Tsaoka [sic] fail to combine for rejections.” The Patent Office supplements this summary with the text on page 17 of the current Office Action. The text on page 17 mirrors the text on pages 2-3 of the current Office Action. The text diverges from the earlier text by stating “[those] skilled in the art must recognize that there are a plurality of users **NOT just only one user** will receive when the event occurrence and the location indicia correlate with an event criteria and location criteria.” (emphasis in original). Applicant is unsure as to how this language justifies the combination of the references, because the quoted language does not constitute actual evidence to support the motivation to combine the references. On page 18 of the current Office Action, the Patent Office repeats its earlier proffered motivation to combine the references, but once again fails to provide any evidence to support this motivation. Absent the requisite actual evidence, the combination is improper. Applicant timely raised this issue in its previous response, and the Patent Office to date has not shown any evidence to support the motivation to combine the references.

Since the combination is improper, the references must be considered alone. As explained in the previous response, the references alone do not establish obviousness, and the claims are allowable.

Applicant’s next argument in the previous response was that the Patent Office was ignoring the portions of Amin that teach away from the combination. Specifically, Amin teaches a push model that forces unwanted content on the user. Allowing a user to create a profile, which determines what information the user receives, defeats the purpose of the push model and precludes the advertisers from forcing the unwanted content on the users. Thus, a user-defined profile renders Amin unsuitable for its intended purpose. As the MPEP instructs, making a

reference unsuitable for its intended purpose is evidence of non-obvious. MPEP § 2143.01. The Patent Office has not responded to this argument. Since the Patent Office has not produced any evidence that rebuts this argument, the argument weighs against a finding that the combination is obvious.

Since the combination is improper, the rejection of claims 1-7 and 11-23 based thereon is improper, and the claims are allowable.

Even if the combination is proper, a point which Applicant does not concede, Applicant further traverses the Patent Office's assertion that the combination teaches or suggests sending information to a plurality of communication devices. The Patent Office admits that Amin does not show this element, and relies on Tsoukas to teach the element. Specifically, the Patent Office opines on page 17 that "[those] skilled in the art must recognize that there are a plurality of users **NOT just only one user** will receive when the event occurrence and the location indicia correlate with an event criteria and location criteria." (emphasis in original). This statement highlights how the Patent Office misunderstands the claimed invention. The claim recites "sending information to a plurality of communication devices when the event occurrence and location indicia correlate with an event criteria and location criteria defined in a user-desired profile." That is, the claim requires that the information is sent to multiple devices based on one user profile. The Patent Office's statement indicates that multiple users are notified when there is correlation between the profile's location criteria and profile's event occurrence, and the determined event occurrence and determined location indicia respectively. Applicant respectfully disagrees that the combination of references teaches that multiple users are sent information when there is a match between a single profile (as recited in the claim) and the determined event and location. If multiple user's devices are sent information, it is because there are matches in their respective profiles to separately determined events and locations. The references, alone or in combination, do not teach or suggest a single profile that causes information to be sent to a plurality of devices as recited in the claim.

Both independent claims 1 and 17 recite sending the information to a plurality of communication devices. To this extent, claims 1-7 and 17-19 are independently not obvious over the rejection of record. Since the Patent Office has not established obviousness for claims 1-7 and 17-19, the claims are allowable.

Claims 8-16 were rejected under 35 U.S.C. § 103 as being unpatentable over Amin in view of Tsoukas and further in view of Asaoka et al. (hereinafter "Asaoka"). Applicant respectfully traverses. The standard for obviousness is set forth above.

Applicant argued in the previous response that this rejection was based on the flawed combination of Amin and Tsoukas addressed above. This position remains true, and the Patent Office's most recent arguments are insufficient to satisfy the burden placed on the Patent Office in establishing obviousness.

Applicant further argued in the previous response that the motivation to combine Asaoka with Amin and Tsoukas was not supported by actual evidence, as required by the Federal Circuit. The Patent Office misunderstands this argument, stating "[the] reference of Asaoka should not be used as 'notifying weather updates to a visitor/traveler for preparing or making a decision to go over or not' which does not establish obviousness." This statement is not an accurate summary of Applicant's argument. Applicant stated that the Patent Office asserted this as the motivation to combine the references, but had not supported this motivation with actual evidence as required by the Federal Circuit. Therefore, since the motivation was not properly supported, the motivation was improper, and the combination was improper. Since the combination was improper, the Patent Office had not established obviousness.

The Patent Office's arguments on page 18 of the current Office Action are insufficient to show the evidence required by the Federal Circuit. Specifically, the Patent Office repeats the motivation and then fails to provide any citation to support the proposition that it is desirable to in the system of Amin and Tsoukas to have weather updates. Since the Patent Office has not provided the evidence mandated by the Federal Circuit, the Patent Office has failed to support the motivation, and the motivation is improper. Since the motivation is improper, the combination is improper, and the Patent Office has not established obviousness.

Applicant requests reconsideration of the rejections in light of the remarks presented herein. The combinations are improper because the motivations to combine the references are not properly supported. Furthermore, the combinations do not show sending the information to a plurality of devices based on a single user profile. Applicant earnestly solicits claim allowance at the Examiner's earliest convenience.

Respectfully submitted,

WITHROW & TERRANOVA, P.L.L.C.

By:



Taylor M. Davenport
Registration No. 42,466
P.O. Box 1287
Cary, NC 27512
Telephone: (919) 654-4520

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